

The opinion in support of the decision being entered today is not binding precedent of the Board.

Filed by: Mark Nagumo
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Paper 1

Filed
9 October 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

THE UNITED STATES
AS REPRESENTED BY THE NATIONAL INSTITUTES OF HEALTH
(Patents 5,264,423, 5,276,019, and 5,286,717),

Junior Party

v.

JOHN GOODCHILD and PAUL C. ZAMECNIK
(Application 08/346,270)

Senior Party.

Patent Interference 105,040

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application and patents, count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

MAILED

OCT - 9 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Part B. Judge designated to handle the interference

Administrative Patent Judge Mark Nagumo has been designated to handle the interference. 37 CFR § 1.610(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for taking action in the interference is scheduled for 2:00 p.m. on December 11, 2002 (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party

(i)

Named Inventors: Jack S. Cohen, USA
Len Neckers, USA
Cy Stein, USA
Shee L. Loke, USA
Kazuo Shinozuka, Japan
Gerald Zon, USA
Makoto Matsukura, Japan

Patent: 5,264,423¹

(ii)

Named Inventors²: Jack S. Cohen, USA
Kazuo Shinozuka, Japan
Gerald Zon, USA
Makoto Matsukura, Japan

Patent: 5,276,019³

(iii)

Named Inventors: Jack S. Cohen, USA
Len Neckers, USA
Cy Stein, USA
Shee L. Loke, USA
Kazuo Shinozuka, Japan

¹ U.S. Patent No. 5,264,423 issued from:
application 07/976,733, filed November 16, 1992, which is a continuation of
application 07/159,017, filed Feb 22, 1988, which is a continuation in part of
application 07/030,073, filed March 25, 1987, now abandoned.

² A petition to change inventorship was filed and granted, but a certificate of correction was not issued. After the parties have ordered copies of the files, the file for U.S. Patent 5,276,019 will be hand-carried to the Certificate of Corrections Branch for issuance of the certificate. A copy of the certificate will then be mailed to the parties.

³ U.S. Patent No. 5,276,019 issued from:
application 07/159,017, filed Feb 22, 1988, which is a continuation in part of
application 07/030,073, filed March 25, 1987, now abandoned.

Interference 105,040
United States v. Goodchild

Paper 1

Patent: 5,286,717⁴

Title: Inhibitors for replication of
retroviruses and for the expression of
oncogene products

Assignee: United States of America, as represented
by the Department of Health and Human
Services

Accorded Benefit: Application 07/030,073,
filed March 25, 1987

Attorneys: See last page

Address: See last page

⁴ U.S. Patent No. 5,286,717 issued from:
application 07/976,777, filed November 16, 1992, which is a division of
application 07/159,017, filed Feb 22, 1988, which is a continuation in part of
application 07/030,073, filed March 25, 1987, now abandoned.

Senior Party

Named inventors: John Goodchild, USA
Paul C. Zamecnik, USA

Patent: 08/346,270,⁵
filed November 23, 1994

Title: Inhibition of HTLV-III by exogenous
oligonucleotides

Assignee: University of Massachusetts, Worcester

Accorded Benefit: (i) U.S. Application 07/882,073,
filed May 12, 1992, now abandoned

(ii) U.S. Application 07/798,263,
filed November 18, 1991, now abandoned

(iii) U.S. Application 07/160,574,
filed February 26, 1988, now abandoned

(iv) U.S. Application 07/071,894,
filed July 10, 1987, now abandoned

(v) U.S. Application 06/867,231,
filed May 23, 1986, issued as U.S.
Patent No. 4,806,463, granted on
February 21, 1989

Attorneys: See last page

Address: See last page

⁵ A terminal disclaimer has been filed against U.S. Patent 4,806,463.

Part F. Count and claims of the parties

Count 1

The compound according to claim 1 of U.S. Patent No. 5,264,423, or the compound according to claim 17 of application 08/346,270.

The claims of the parties are:

Cohen, U.S. Patent 5,264,423:	1-48
Cohen, U.S. Patent 5,276,019:	1-43
Cohen, U.S. Patent 5,286,717:	1-20
Goodchild, U.S. Application 08/346,270:	17-19, 21-25, 27, 44-46, 48-52, 54-56, 58, 61, and 64

The claims of the parties which correspond to Count 1 are:

Cohen, U.S. Patent 5,264,423:	1-48
Cohen, U.S. Patent 5,276,019:	1-43
Cohen, U.S. Patent 5,286,717:	1-20
Goodchild, U.S. Application 08/346,270:	17-19, 21-25, 27, 44-46, 48-52, 54-56, 58, 61, and 64

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Cohen, U.S. Patent 5,264,423:	none
Cohen, U.S. Patent 5,276,019:	none
Cohen, U.S. Patent 5,286,717:	none
Goodchild, U.S. Application 08/346,270:	none

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper ____⁶

Filed on behalf of [name of party]
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Mark Nagumo)

THE UNITED STATES
AS REPRESENTED BY THE NATIONAL INSTITUTES OF HEALTH
(Patents 5,264,423, 5,276,019, and 5,286,717),

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(Application 08/346,270)

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Patent Interference 105,040

TITLE OF PAPER

⁶ Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

1. § 7: date for identifying lead and backup counsel.
2. § 8: date for identifying any real party in interest.
3. § 9: date for requesting copies of involved and benefit applications and patents.
4. § 17: date for filing list of proposed preliminary motions.
5. § 19: date for accomplishing certain discovery.
6. § 20: date for filing clean copy of claims.
7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
12. § 45: dates for taking action with respect to settlement discussions

Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference 105,040 (Nagumo)

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____

Part J. Signature of administrative patent judge


Mark Nagumo
Administrative Patent Judge

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in
the testimony and briefing phases of the interference
(ORDERTE6)

Copy U.S. Patent No. 5,264,423

Copy U.S. Patent No. 5,276,019

Copy U.S. Patent No. 5,286,717

Copy of claims of U.S. Application 08/346,270

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Revised September, 2000

(replaces DECLARE.006.1)

Interference 105,040
United States v. Goodchild

Paper 1

105,040
cc (via Overnight Delivery):

Attorney for Cohen
(Real party in interest
assignee United States of America, as represented by the
Department of Health and Human Services)

(Counsel of record for Assignee)

Kenneth A. Weber
TOWNSEND AND TOWNSEND AND CREW, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

Tel. (415) 576-0200
Fax: (415) 576-0300
E-mail: None

Attorney for Goodchild
(Real party in interest
assignee University of Massachusetts, Worcester)

Counsel for assignee:

Michael S. Greenfield
MCDONNELL BOEHNEN HULBERT & BERGHOFF
300 South Wacker Drive
Chicago, IL 60606

Tel. (312) 913-0001
Fax: (312) 913-0002
E-mail: None

Counsel of record:

Wayne A. Keown
HALE AND DORR LLP
60 State Street
Boston MA 02109

Tel. (617) 526-6000
Fax: (617) 526-5000
E-mail: None